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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,476	11/08/2001	Keisuke Tanaka	2091-0247P	5608

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EXAMINER
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MILIA, MARK R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/986,476

Applicant(s)

TANAKA, KEISUKE

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The Oath/Declaration is missing. Applicant is requested to furnish the Office with an Oath/Declaration containing all necessary information.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 13, reference character (S46) and Fig. 14, reference character (S55). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 8, 10, 15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6657702 to Chui et al.

Regarding claim 1, Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of

the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52).

Regarding claim 8, Chui discloses a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), wherein the server stores the image data transferred thereto regardless of whether or not the order is placed at the time of transfer of the image data, and receives the order for the print regarding the image data stored therein after the image data are stored therein in the case where the order was not placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Regarding claim 15, Chui discloses a computer-readable recording medium storing a program to cause a computer to execute a print ordering method used in a print ordering system, the print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the program comprising the procedures of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65 and column 12 lines 39-51) and receiving the order for the print of the image data

stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52).

Regarding claims 3, 10, and 17, Chui discloses the system discussed in claims 1, 8, and 15, and further displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui as applied to claims 1, 8, and 15 above, and further in view of U.S. Patent No. 5974401 to Enomoto et al.

Chui discloses accepting and storing image data (see column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-column 14 line 8 and column 14 lines 47-52).

Chui does not disclose expressly accepting and storing the image data at the time the order is received if the order is placed at the time the image data are transferred.

Enomoto discloses accepting and storing the image data at the time the order is received if the order is placed at the time the image data are transferred (see abstract, column 3 lines 45-48 and 61-63, column 4 lines 61-65, column 6 lines 23-54, and column 7 lines 15-22, reference shows that the order data and image data are transmitted at the same time to the photo-finisher for output and delivery of prints).

Chui & Enomoto are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ability to transmit order data and the same time as image data to obtain digital prints as described by Enomoto with the system of Chui.

The suggestion/motivation for doing so would have been to provide added convenience for a user by allowing the user to place an order for prints at the time the images are sent when the user already knows what particular images they desire prints for.

Therefore, it would have been obvious to combine Enomoto with Chui to obtain the invention as specified in claims 2, 9, and 17.

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5. Claims 4-7, 11-14, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui as applied to claims 1, 8, and 15 above, and further in view of U.S. Patent No. 6154295 to Fredlund et al.

Regarding claims 4, 11, and 18, Chui does not disclose expressly deleting the image data from the server after a predetermined storage period has elapsed since the image data were put into storage.

Fredlund discloses deleting the image data from the server after a predetermined storage period has elapsed since the image data were put into storage (see column 3 lines 41-54).

Regarding claims 5, 12, and 19, Chui does not disclose expressly extending the storage period for the image data regarding which the order was placed.

Fredlund discloses extending the storage period for the image data regarding which the order was placed (see column 3 lines 47-54).

Regarding claims 6, 7, 13, 14, 20, and 21, Chui does not disclose expressly displaying the storage period on the user terminal.

Fredlund discloses displaying the storage period for the image data (see column 3 lines 41-57).

Chui & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the deletion of image data after a predetermined period of time and extension of storage period and the ability to display both as described by Fredlund



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and displaying the information regarding storage period on a user terminal, which is well known in the art, with the system of Chui.

The suggestion/motivation for doing so would have been to provide a user with greater control over the transmitted images and decrease the amount of memory needed to store image data by purging the image data that is not used after a predetermine amount of time.

Therefore, it would have been obvious to combine Fredlund with Chui to obtain the invention as specified in claims 4-7, 11-14, and 18-21.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to the attached Notice of References Cited.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia  
Examiner  
Art Unit 2622

MRM

  
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